

REMARKS

In the Office Action mailed 3/09/05, Claims 1-5, 10-13, 16-19, and 22-25 remain rejected under 35 USC 102(b) as being anticipated by Chen et al. (U.S. 5,832,208). The remaining claims in this rejection are dependent upon either claim 1, 10, 16 or 22 and thus incorporate all of the limitations of these respective base claims. Applicant again respectfully traverses the 102(b) rejection based on Chen.

Applicant asserts that it has not been shown where Chen discloses intercepting incoming files before they reach a file system. In fact, Chen discloses the opposite. Examiner's attention is directed to Chen's explanation of FIG.3 on Col. 7, reproduced below for the Examiner's convenience:

Although the agent 110 of the present invention is generic to both databases and e-mail systems, for the sake of simplicity, the following discussion shall discuss only the scanning of e-mail messages. Further, it is assumed that a complete scan of all e-mail messages (i.e., all attached files for all databases and mail boxes) is to take place. In step 200, the agent 110 determines whether an attachment is present in an e-mail message. If an attachment does not exist, then the Agent 110 determines in step 240 whether the entire mail system 140 has been scanned. If the entire mail system 140 has been scanned, then the agent 110 ceases operation. If, however, the entire mail system 140 has not been scanned, then the agent 110 proceeds to the next e-mail message (step 235). If an attachment is present in an e-mail message, the agent 110 detaches the attachment (step 205), and it sends the attachment to the anti-virus application 120 (step 210). If the anti-virus application 120 does not detect the presence of a virus in the attachment (step 215), then the agent 110 reattaches the attachment to the original e-mail message (step 220).

Chen describes a system that scans an email (file) system for files having attachments that might bear viruses. Specifically, attention is drawn to Chen's statement *In step 200, the agent 110 determines whether an attachment is present in an e-mail message. If an attachment does not exist, then the Agent 110 determines in step 240 whether the entire mail system 140 has been scanned. If the entire mail system 140 has been scanned, then the agent 110 ceases operation. If, however, the entire mail system 140*

Docket No.: CISCO-2402

has not been scanned, then the agent 110 proceeds to the next e-mail message (step 235).

Thus, Applicant asserts that Chen's invention is simply combing through a file system (the email system) for emails that have attachments, and these emails have already been placed in the file system (email system).

If an attachment is not found, agent 110 proceeds to the next email message. Absent some indication that these email messages being scanned are NOT in an email system, it must be assumed that they are, as Chen teaches proceeding to the next email message, not waiting for the next email message to arrive. Why else would Chen be checking to determine whether the entire email system has been scanned, other than to make a determination that any virus that already landed in the email system has been detected. If Chen indeed was scanning incoming emails before they reached the email system, why would there be a need to determine whether the email system has been scanned? Thus, Applicant submits that Chen teaches scanning of a file system that does not occur until after the message (and its attachment) reaches the file system.

Directing Examiner's attention to MPEP 2131, the threshold issue under Section 102 is whether the Examiner has established a *prima facie* case for anticipation. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)". "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989). The elements must be arranged as required by the claim but this is not

Docket No.: CISCO-2402

an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Bariant, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Because Chen lacks the limitation of intercepting incoming files before they are transferred to a file system, Applicant respectfully submits that Chen does not contain all of the elements of claims 1 and 10 and thus a 35 USC 102 rejection cannot be sustained.

Claims 6, 14, 20 and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al in view of Hodges et al. (U.S. 6,269,456). Applicant respectfully traverses this rejection. Claim 6 depends from claim 1 and thus contains all of claim 1's limitations. Applicant incorporates its argument from above regarding Chen and claim 1 of the present application and respectfully asserts that because claim 1 is not anticipated by Chen, claim 6 is not anticipated by Chen or Hodges, as neither of the cited prior art teach the limitations of claim 1 of the present invention. The same argument applies to rejected claim 14 (depending from claim 10), claim 20 (dependent from claim 16), and claim 26 (dependent from claim 22).

Claims 8 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. in view of Tso et al (U.S. 6,088,803). Applicant respectfully traverses this rejection

05-09-2005 19:24

From-SIERRA PATENT GROUP

7755869550

T-402 P.012/013 F-830

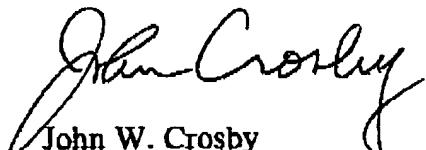
Docket No.: CISCO-2402

and incorporates the above analysis of claim 1 with respect to Chen. As Chen and Tso do not teach, disclose, nor otherwise suggest the limitations of claim 1, and claims 8 and 9 depend from claim 1, claims 8 and 9 are thus patentable because they incorporate all of the limitations of claim 1 of the present application.

CONCLUSION

Based on the foregoing, Applicant asserts that the claims, as currently amended, are patentable over Examiner's cited prior art. Early allowance of claims 1-27 is requested. If the Examiner feels there are any remaining issues that can be resolved by telephone, the Examiner is invited to call the undersigned attorney at the phone number appearing below.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.



John W. Crosby
Reg. No.: 49,058

Dated: May 9, 2005

Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline, NV 89449
(775) 586-9500
(775) 586-9550 Fax